

REMARKS

Claims 1-51 and 54 are pending in the present application. By this Amendment, new claim 54 is added. Claims 43-51 are allowed. Claims 8-23 are withdrawn from consideration.

Claims 1-7 and 53 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Williams et al. (U.S. Patent No. 6,024,019; hereinafter “Williams”) in view of Corrado et al. (U.S. Patent No. 6,196,128; hereinafter “Corrado”) and newly cited Naniwa et al. (U.S. Patent No. 6,474,236; hereinafter “Naniwa”). Claims 24-42 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Williams in view of Corrado and newly cited Shinoda (U.S. Publication No. 2001/0017996; hereinafter “Shinoda”). Applicant submits that following in traversal.

Rejection of Claims 1-7 and 53 Under § 103(a) Over Williams in View of Corrado and Naniwa

Applicant respectfully submits that claims 1-7 and 53 are patentable.

The Examiner relies on newly cited Naniwa to show a flexible plate with a plurality of distributed holes. As with the Williams reference applied in previous Office Actions (refer to our letter of October 21, 2005), Applicant respectfully submits that the Examiner is confusing the flexible plate recited in claims 1-7 and 53 with the recording medium described in Naniwa. In both Williams and Naniwa, the structure characterized by the Examiner as corresponding to the claimed flexible plate *is* the recording medium. Claim 1 recites:

wherein the plurality of distributed holes in the flexible plate coincide to a degree with the plurality of suction ports on the fixed surface of the recording medium fixing member such that suction from the suction apparatus is transmitted through the flexible plate to the recording medium.

With reference to Figure 2 of Naniwa, the holes 14a, 14b in the press plate 13 to which the Examiner refers are for engaging corresponding protrusions on a cylinder (Naniwa, col. 9, ll. 15-23). The engagement of the holes 14a, 14b with the protrusions causes the press plate 13 to be held on the cylinder. Naniwa neither shows nor suggests distributing the holes with respect to suction ports, as recited in the claim.

Applicant also argues that claims 1 and 5-7 are patentable because a *prima facie* case of obviousness has not been established. Specifically, there is no motivation to combine Williams, Corrado, and Naniwa as proposed by the Examiner. To establish a *prima facie* case of obviousness, “there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.” MPEP § 2143. There can be no motivation to combine or modify the references if the proposed modification would render the prior art invention unsatisfactory for its intended purpose. *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984).

Distributing the holes as recited in amended claims 1 and 5-7 would render the printing apparatuses disclosed by Williams and Naniwa unsatisfactory for their intended use. As noted above, the Examiner characterizes the recording media of Williams and Naniwa as the flexible plate recited in claims 1 and 5-7. Distributing holes in the printing structure 122 of Williams and/or plate material 13 of Naniwa to coincide with suction ports as recited in amended claims 1 and 5-7 would significantly degrade the image quality, i.e., make Williams unsatisfactory for its intended purpose of printing. Accordingly, there is no motivation to combine or modify Williams, Corrado, and Naniwa.

Thus, at least for the reasons above, claims 1 and 5-7 are patentable.

Claims 2-4 and 53, which depend from claim 1, are patentable for at least the reasons submitted for claim 1.

Applicant adds new claim 54 to further define the invention with respect to the changes to claim 1.

Rejection of Claims 24-42 under §103(a) Over Williams in View of Corrado and Shinoda

Applicant submits that claims 24-42 are patentable because a *prima facie* case of obviousness has not been provided. A *prima facie* case of obviousness does not exist because there is no motivation to combine Williams, Corrado, and Shinoda. Specifically, it is improper to combine references when the references teach away from their combination. *In re Grasselli*, 713 F.3d 731 (Fed. Cir. 1983). Shinoda expressly teaches away from a crown shaped roller. Williams and Corrado do not contradict the teachings of Shinoda.

Each of the prior art references must be considered as a whole when forming an obviousness rejection. MPEP 2141.02(VI). Applicant respectfully submits that the Examiner has merely taken individual components recited in independent claims 24 and 35 without regard for the context in which they are shown in the cited references. Specifically, Shinoda discloses a crown shaped squeezing roller in Figure 5. The Examiner, however, fails to consider the accompanying text in the Background section of Shinoda. Shinoda expressly states that the crown shape in the prior art shown in Figure 5 results in unevenness in “field gap” (Shinoda, ¶ [0005]). In embodiments disclosed by Shinoda in Figures 2 and 3, cylindrical rollers are provided in place of the prior art crown shape as part of a solution to the unevenness (Shinoda, ¶ [0050]). This teaching is directly contrary to that of the present application, which teaches that a crown shape can provide a uniformly dispersed pressing force (¶ [0155]). Thus, Shinoda teaches

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away from using a crown shaped roller in a cleaning operation of a recording apparatus, as recited in claims 24 and 35. Corrado and Williams do not contradict Shinoda, as both provide rollers with cylindrical shapes.

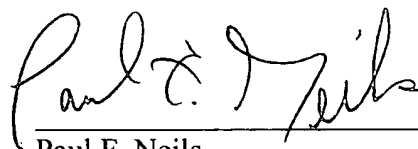
For at least the reasons stated above, claims 24 and 35 are patentable.

Claims 25-34 and 36-42, which depend from claims 24 and 35, are patentable for at least the reasons submitted for claims 24 and 35.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Paul F. Neils", written over a horizontal line.

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